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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,728	11/25/2003	Christian J. Lee	CR30Q-US	5766
60723	7590	05/23/2006	EXAMINER	
AVON PRODUCTS, INC. AVON PLACE SUFFERN, NY 10901			MERCIER, MELISSA S	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/721,728

Applicant(s)

LEE ET AL.

Examiner

Melissa S. Mercier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a cosmetic composition comprising: a cellulose-based film forming agent, b. a polyurethane resin, classified in class 424, subclass 401.
- II. Claims 14-23, drawn to a nonaqueous cosmetic composition comprising: a cellulose-based film forming agent and a polyurethane resin, classified in class 424, subclass 401.
- III. Claims 24-26, drawn to a nonaqueous nail polish comprising: a solvent, a primary film former, an aliphatic, a stabilizing agent and a pigment, classified in class 424, subclass 061.
- IV. Claim 27, drawn to a method of imparting an improved flexibility, durable, and/or transfer resistant cosmetic coating using the composition of Invention I, classified in class 424, subclass 061.
- V. Claim 28, drawn to a method of imparting an improved flexibility, durable, and/or transfer resistant cosmetic coating using the composition of Invention II, classified in class 424, subclass 061.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs,

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modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are both cosmetic compositions comprising a cellulose-based film forming agent and a polyurethane resin; however, Invention II is specified to be nonaqueous.

Inventions I and III are unrelated. In the instant case, the different inventions are both related to compositions; however, they have materially different designs. Invention I is drawn to a composition comprising cellulose based film forming resin and a polyurethane resin, whereas Invention III is drawn to a nonaqueous nail polish comprising a solvent, a primary film former, an aliphatic, a stabilizing agent and a pigment.

Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process of using can also be accomplished by using the composition of Invention II.

Inventions I and V are related as product and process of use. In the instant case the process does not require the composition of Invention I.

Inventions II and III are unrelated. In the instant case, the different inventions are both nonaqueous compositions, however, they have materially different designs. Invention II is drawn to a composition comprising: a cellulose based film forming agent

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and a polyurethane resin. Whereas, Invention III is drawn to a composition comprising: a solvent, a primary film former, an aliphatic, a stabilizing agent and a pigment.

Inventions II and IV are related as product and process of use. In the instant case the method of Invention IV does not require the composition of Invention II, but instead using the composition of Invention I.

Inventions II and V are related as product and process of use. In the instant case the method of Invention V can be performed using the composition of Invention I.

Inventions III and IV are related as product and process of use. In the instant case the method described in Invention IV does not require the use of Invention III. The method is drawn to a method of imparting an improved flexibility, durable, and/or transfer resistant cosmetic coating using the composition of Invention I.

Inventions III and V are related as product and process of use. In the instant case the method described in Invention IV does not require the use of Invention III. The method is drawn to a method of imparting an improved flexibility, durable, and/or transfer resistant cosmetic coating using the composition of Invention II.

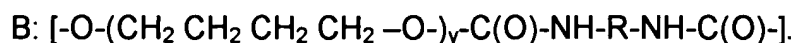
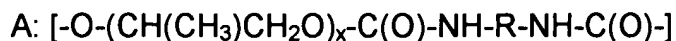
Inventions IV and V are unrelated. In the instant case, the different inventions are both methods for imparting an improved flexibility, durable, and/or transfer resistant cosmetic coating; however, the methods employ material different designs in the fact that they are dependent on materially different compositions.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02),

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restriction for examination purposes as indicated is proper. Searching all the claimed inventions together would create a search burden on the examiner.

This application contains claims directed to the following patentably distinct species: polyurethane resins having the general structures:



The species are independent or distinct because the polyurethane resin structures are different.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1 and 14 are drawn to a generic polyurethane resin.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

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The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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